

REMARKS

Claims 1-10 and 12-23 are pending and all were rejected under 35 U.S.C. § 103. Claims 1, 2, 3, 9, 10, 15, 16, 18, 19, and 21 are being amended. Dependent claim 8 is being canceled with its feature being incorporated into independent claims 1, 15, 16, and 19. A paragraph in the Specification is being amended. In view of the above amendments and following remarks, reconsideration of the application is respectfully requested.

AMENDMENT TO THE SPECIFICATION

The paragraph of page 15, line 18 to page 16, line 7 is being amended.

REJECTIONS UNDER 35 U.S.C. § 103(a) – Philippou and Ylonen

On page 2 of the above mentioned Final Office Action, claims 1-10 and 12-23 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. patent number 6,385,648 issued to Philippou et al (“Philippou”) in view of U.S. patent number 6,782,474 issued to Ylonen (“Ylonen”).

The rejection is traversed. The claimed inventions are patentably distinguished from Philippou and Ylonen, either alone or in combination. The alleged motivation for combining Philippou and Ylonen is improper. Showing a prima facie case of obviousness fails.

Philippou and Ylonen, either alone or in combination, do not disclose every element of the claimed invention. As indicated in the Amendment (“Amendment”) in response to the first Office Action (“Office Action”), and it is hereby resubmitted that Philippou “does not disclose the element ‘wherein the first device provides administrative capabilities to a second device as recited in claim 1. For the sake of argument that Philippou’s box 201 in conjunction with configuration utility 231

corresponds to the claimed configuring machine, and Philippou's to-be-initialized box 205 corresponds to the claimed 'first device' to be configured, Philippou does not teach that box 205 'provides administrative capabilities' to a second device as the claimed first device."

The Final Office Action, on page 9, 1st paragraph, asserted that "Philippou does disclose this feature [(provide administrative support)] by disclosing that the computer system may be used for the other boxes as well and will interface with external systems or boxes connected on a network in turn providing administrative capabilities to [sic], tools managing, and providing interactions between a second and a third device to a second device (column 2, 60-67, column 3, 43-50)." It is respectfully submitted that Philippou does not recite "the computer system *may be used* for the other boxes" (emphasis added) as asserted. In fact, Philippou discloses that "a computer system may be *used to perform many of the functions* [of] other boxes 203, 205, 207. . ." (emphasis added). As such, in Philippou, a computer may be used to perform many functions of box 205 (the claimed first device). For example, since box 205 in Philippou may be a router, a bridge, switch, etc., then a computer may be used to perform many functions of such router, bridge, switch, etc. However, there is no teaching that box 205 can provide administrative support to a second device.

Even though Ylonen discloses "a network device may want to disable listening for configuration packets once it has been configured" (col. 9, lines 1-2), Ylonen does not teach the claimed element "turning-off a feature to configure the first device *until the first device is in an un-configured state*" (emphasis added) in claim 1. Those skilled in the art will recognize that many devices, even having been configured, allow a new configuration to change the current configuration whereas the claimed invention does not allow such new configuration/change of the current configuration once the

first device has been configured. However, if the device is in an un-configured state again, then the claimed invention allows the configuration. There is no such teaching in Ylonen.

Claim 1 now includes the feature of canceled claim 8 and recites “the first device is embedded in a second device” where as canceled claim 8 recited “. . . the first device being part of the second device.” The rejection of claim 8 is now discussed. Both the Office Action and the Final Office Action asserted that “[i]n Philippou et al . . . the computer system may include the *network interface as part of the system . . .*” (emphasis added). The Final Office Action, on page 10, third paragraph, also asserted “*the first device which is the network interface* which can also be connected to the to be configured box which makes it part of the second device . . .” (emphasis added). Thus both the Office Action and the Final Office Action asserted that Philippou’s network interface corresponds to the claimed first device, which is the device to be configured. It is respectfully submitted that Philippou discusses *initialization of box 205*, but does not teach configuration of the *network interface*. It was the *Office Action’s and Office Action’s assertion* of configuring the network interface. In any event, if Philippou’s box 205 corresponds to the claimed first device, then there is no teaching in Philippou regarding box 205 being part of/embedded in a second device as in claim 1. If Philippou’s network interface corresponds to the claim first device, then there is no teaching regarding configuration of such network interface.

For combining the two references in a § 103-obvious rejections, it must be shown that the references teach or suggest such combination or that such combination is of general knowledge (MPEP, section 706.02(j)). Here, there is no teaching or suggestion of combining Philippou and Ylonen in either Philippou or Ylonen, and both the Office Action and the Final Office Action failed to show it is of common

knowledge to combine the initialization of Philippou to the installation and configuration of the network device of Ylonen. The Final Office Action, on page 3, 3rd paragraph, asserted that “it would have been obvious . . . to use the disabling feature in Ylonen with the method in Philippou because configuration data can be loaded in a reliable manner (Ylonen, column 2, 58-63).” Even though the Final Office Action correctly indicated that Ylonen desires to load configuration data into the network device in a reliable manner, the assertion of combining the two teachings of Philippou and Ylonen to achieve such goal is a general conclusory statement without providing supporting evidence. Therefore, showing a *prima facie* of obviousness fails.

For the foregoing reasons, claim 1 is patentably distinguished from Philippou and Ylonen, either alone or in combination, and is therefore patentable. Claims 2-14, depending from claim 1, are patentable for at least the same reasons as claim 1. Claims 2-14 are also patentable for their additional limitations.

Regarding claim 2, both the Office Action and the Final Office Action asserted that Philippou “discloses a network interface, which is part of and can be embedded in the first device and can provide console capabilities to the first device (column 3, 43-50). The Final Office Action further indicated that Philippou’s network interface corresponds to the claimed first device, which is the device to be configured. It is respectfully submitted, as discussed above, that Philippou discusses initialization of box 205, but does not teach configuring the *network interface*. It was the *Final Office Action’s assertion* of configuring the network interface. If Philippou’s box 205 corresponds to the claimed first device, then this box 205 does not provide console capabilities to a second device as claimed in claim 2 because “box 205 . . . may be network bridges, routers, switches or the like” (col. 3, lines 4-6). Those skilled in the art will recognize that bridges and routers do not provide console capabilities, which,

in an illustrative embodiment, include “allowing a user via a console client to have the same set of functionalities and levels of controls of server 110. Service processor 120 allows interactions between a console client and program applications on server 110” (Applicants’ Specification, lines 7-10). In contrast, bridges, routers, and switches forward data packets in networks.

The Office Action then continued “which [the network interface] can also be connected to the to be configured box which makes it part of the second device and inherently since the network interface is providing the information from the configuring machine the device is providing console capabilities to the second device.” Here, the Final Office Action corresponds Philippou’s network interface to the claimed first device. The Final Office Action then asserted that the network interface is part of the computer system 301, which is corresponded to the claimed second device. However, as discussed above, there is no teaching in Philippou that this network interface provides console capabilities to the computer system. In fact, Philippou teaches that “[t]his modem or network interface 319 may be an analog modem, ISDN modem, cable modem, DSL modem, token ring interface, Ethernet interface, satellite transmission interface, or other interfaces for coupling a computer system or box to other computer systems or boxes” (col. 3, lines 54-59). Those skilled in the art will recognize that functionality of a modem or network interface is not patentably the same as providing console capabilities as discussed above.

It is not clear what the Final Office Action meant by “. . . and inherently since the network interface is providing the information from the configuring machine the device is providing console capabilities to the second device” (Final Office Action, page 9, second paragraph, last three lines). If the Final Office Action asserted that it is inherent that the network interface provides console capabilities to a second device, then the Final Office Action erred in such assertion. The Final Office Action, like the

Board in re Zurko, 258 F. 3d, 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001), cannot reach the conclusions based on its own understanding or findings. Rather, the Final Office Action must point to some concrete evidence to support its findings. Here, there is no evidence pointing to inherency that the network interface provides console capabilities to a second device. In brief, it is respectfully submitted that Philippou does not disclose the claimed first device that can provide console capabilities to another device.

Regarding claim 3, both the Office Action and the Final Office Action asserted that “Philippou . . . shows in Figure 4, a table, which holds the information for the network it has configured and sends information from this table to the device. It is again respectfully submitted that Philippou’s table 4 is a display of the boxes found after configuring utility 231 receives the acknowledgement from box 205, which is patentably distinguished from the claimed table in which the first parameter is sent to this table and, from this table, the first parameter is obtained.

Regarding claim 5, the Final Office Action, on page 10, first paragraph, asserted that “Philippou et al discloses a unique identifier, which includes a serial number (column 3, 16-18).” The Final Office Action then argued “[i]t is widely known that the media access control address is a unique device identifier.” Even for the sake of argument that the media access control address is a unique device identifier, the prior art of record, e.g., Philippou, does not disclose that the device identifier is a media access control address of the first device. Reading together with claim 1, there is no disclosure in Philippou regarding using the media access control address of the first device so that the first device can be identified and thus configured. To be parallel with claim 1, Philippou must, but does not, disclose using the media access control address of box 205 so that box 205 can be identified and thus configured. Since Philippou discloses using the serial number as a unique identifier

for box 205, the claimed “media access control address” is patentably distinguished from this serial number of box 205 in Philippou.

Regarding claim 6, both the Office Action and the Final Office Action asserted that Philippou showed that network interface communicating with external systems and boxes. The Final Office Action, on page 10, second paragraph, then asserted “the network interface communicating with external systems and boxes which *inherently* allows the first device to acquire the first parameter” (emphasis added). As discussed above, there is no disclosure in Philippou that Philippou’s network interface is the device to be configured, which corresponds to the claimed first device. Even if the network interface corresponds to the claimed first device, the assertion of inherency by the Final Office Action was improper because the Final Office Action failed to provide evidence of inherency, that is, the Office Action failed to show that it is inherent that the network interface acquires the parameter for the network interface to be configured. In brief, as indicated in the Amendment, the fact that Philippou’s computer system 301 interfaces to external systems or boxes has nothing to do with the claimed “the first device performing the step of acquiring the first parameter.”

Regarding claim 7, both the Office Action and the Final Office Action asserted that “[i]n Philippou et al . . . the computer system may include the network interface as part of the system, which would allow the second device to obtain, the first parameter and the first device acquire the first parameter from the second device (column 3, 49-53).” The Final Office Action, on page 10, third paragraph, also asserted “the first device which is the network interface which can also be connected to the to be configured box which makes it part of the second device and inherently since the network interface is providing the information from the configuring machine the device is providing console capabilities to the second device.” As discussed

above, the network interface does not correspond to the claimed first device, and the assertion of inherency was improper because the Final Office Action failed to provide evidence for such assertion. Further, the assertion regarding “providing console capabilities to the second device” has no thing to do with the claimed elements in claim 7. In brief, as indicated in the Amendment, “Philippou does not disclose the claim that the first device being part of a second device, and the second device obtaining the first parameter, and acquiring the first parameter from the second device. The assertion that the network interfaces may be considered part of the computer system is not patentably parallel with the claimed invention because the claimed first device was corresponded to *box 205*, not the *interfaces*.”

Discussion related to claim 8 was discussed above in relation to claim 1 because the feature of claim 8 is being incorporated into claim 1.

Regarding claim 9, the Final Office Action reasserted the assertion in the Office Action which recited “[f]igure 3 of Philippou et al discloses the second device being part of a bus which is widely known to consist of” To be parallel with the claimed invention, Philippou must disclose that box 205 being part of a second device, and that box 205 communicates with this second device via an interconnect selected from the list in claim 9. However, Philippou does not disclose such facts.

Regarding claim 10, both the Office Action and the Final Office Action asserted that “the unique identifier includes a serial number of the box, which is the second device (column 3, 16-18). It is widely known that the three options are well known unique identifiers.” Again, both Office Actions’ assertions are without supporting evidence, and Philippou does not disclose the device’s identifier is that of the second device and is from the claimed list. Further, as indicated the Amendment, Philippou’s serial number is patentably distinguished from the claimed device identifier in the list.

Regarding claim 4, Ylonen's cited paragraph of col. 7, lines 20-29, even though discloses the device's IP address, does not disclose, suggest or make obvious the claimed "an address resolution protocol command sending the internet protocol address to the table; and a packet internet groper protocol command obtaining the internet protocol from the table." The Final Office Action, in the section "Response to Arguments" did not provide any respond to the argument related to "an address resolution protocol command," "a packet internet groper protocol," and using those commands as in the claimed invention.

Regarding claim 13, neither Philppou norYlonen discloses the claimed "sending a command with the first parameter in a packet, the command being executed in the first device," etc.

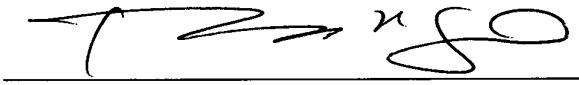
Independent claims 15, 16, and 19 are patentable for reasons that they recite limitations not disclosed in Philppou as discussed above in conjunction with claims 1-11. Dependent claims 17 and 18, and 20-23 depend from claims 16 and 19, respectively, and are patentable for at least the same reasons as claims 16 and 19, respectively. These dependent claims are also patentable for their additional limitations in recited in claims 1-12 with corresponding limitations.

SUMMARY

It is respectfully submitted that pending claims clearly present subject matter that is patentable over the prior art of record, and therefore withdrawal the rejections and allowance of the pending claims are respectfully solicited.

Respectfully submitted,

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